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50735 7590 08/18/2009 AUSTIN RAPP & HARDMAN 170 SOUTH MAIN STREET SUITE 735 SALT LAKE CITY, UT 84101				
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RILEY, MARCUS T				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/786,278

Applicant(s)

CHRISOP ET AL.

Examiner

MARCUS T. RILEY

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
4a) Of the above claim(s) 5-7, 10, 15-17, 20, 24-26 & 29 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4, 8, 9, 11-14, 18, 19, 21-23, 27, 28 & 30-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-849)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02/24/2004
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is responsive to the applicant's remarks received on May 14, 2009. **Claims 1-4, 8, 9, 11-14, 18, 19, 21-23, 27 & 28** remain pending. Newly added **claims 30-32** are also pending. **Claims 5-7, 10, 15-17, 20, 24-26 and 29** are withdrawn from consideration.

Response to Arguments

2. Applicant's arguments with respect to amended **claims 1, 12 & 21** filed on May 14, 2009 have been fully considered but they are not persuasive.

Applicant's Remarks

For Applicant's remarks see "*Applicant Arguments/Remarks Made in an Amendment*" filed May 14, 2009.

Examiner's Remarks:

Applicant has amended independent claims 1, 12 & 21 to reflect the new limitation "*wherein the proof sheet comprises at least one compressed form of a page in the scanned documents.*" Applicant argues that Lopez, alone or in combination with Nomura does not disclose this feature.

Examiner understands the Applicant's arguments but respectfully disagrees. Lopez, either alone or in combination with Nomura discloses, teaches or suggests "*wherein the proof sheet*

comprises at least one compressed form of a page in the scanned documents." column 4, line 63 thru column 5, line 35 of Lopez discloses this feature. See also Fig. 1 #22 wherein #22 is the proof sheet with the compressed thumbnail image 52 that may represent a page or file name. The proof sheet 22 is then placed on scan platen 122 where it is optically scanned by a scanner subsystem 86. Thus, Lopez, either alone or in combination with Nomura discloses, teaches or suggests the applicant's claimed invention.

Claims 2-4, 8, 9 and 11 depend either directly or indirectly from claim 1. Accordingly, the rejection of claims 2-4, 8, 9 and 11 are not withdrawn.

Claims 12 and 21 as amended includes subject matter similar to the subject matter of claim 1. As a result, claims 12 and 21 are not withdrawn.

Claims 13, 14, 18 and 19 depend either directly or indirectly from claim 12. Claims 22, 23, 27 and 28 depend either directly or indirectly from claim 21. As a result, the rejection of claims 13, 14, 18, 19, 22, 23, 27 and 28 are not withdrawn.

Accordingly, these limitations do not render claims patentably distinct over the prior art of record. As a result, the application is not in condition for allowance.

Double Patenting

3. Applicant is advised that should claim 2 be found allowable, claim 11 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-4, 8, 9, 11-14, 18, 19, 21-23, 27 and 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over by Lopez et al. (US 7,142,318 B2 hereinafter, Lopez '318) in combination with Nomura et al. (US 7,173,724 B2, hereinafter, Nomura '724).

Regarding claim 1; Lopez 318 disclose a method for proofing a scan job, the method comprising (See Figures 1a, 1b and 2a where #10 is a printing system 10 includes a multifunction printer 14 having both printing and optical scanning capabilities, #22 is the proof sheet):

printing a proof sheet by the scanner ("*The marked proof sheet is scanned so as to determine marked selection areas, and the image files associated with the marked selection areas are printed.*" column 2, lines 37-39);

wherein said proof sheet is representative of the scan job said proof sheet containing a selected sub-set of the information contained within the scan job so that a user can inspect said proof sheet (See Figure 22 "*The scanned image is communicated from the scanner subsystem 86 to a proof sheet analyzer subsystem 82. The proof sheet analyzer subsystem 82 detects and interprets the markings made by the user in the user designation areas 54 (also known as image selection areas 54) to identify the user-selected image files 2, and associates each of the individual user designation areas 54 with a corresponding image file URL 73 via the identity marker 60.*" column 5, lines 13-23);

wherein the proof sheet comprises at least one compressed form of a page in the scanned documents (See Fig. 1 #22 wherein #22 is the proof sheet with the compressed thumbnail image 52 that may represent a page

or file name. The proof sheet 22 is then placed on scan platen 122 where it is optically scanned by a scanner subsystem 86. See column 4, line 63 thru column 5, line 35);

receive user input corresponding to the proof sheet (“... *proof sheet 22 containing user selection areas 54 is to be printed, marked by the user, and scanned ("Mark Proof Sheet" branch of 161), then at 162 the proof sheet 22 for the qualified image files 3 is printed.*” column 12, lines 31-34).

wherein if the proof sheet is acceptable, the user can accept the scan job with modifying the proof sheet (See Figure 11 #'s 166 & 168 where #166 shows wherein the marked proof sheet 22 is optically scanned to form a scanned image and #168 shows the scanned image is processed to determine the qualified image files that were selected for printing. “*After the user chooses selected ones of the qualified image files 2 for printing by marking the user-designation areas 54 associated with the indicia 52 of the selected image files 2, the user places the marked proof sheet 22 on a scan platen 122 where it is optically scanned by a scanner subsystem 86... When the image files 2 have been retrieved, the proof sheet analyzer 82 sends them to an image printing subsystem 84 along with the printing instructions marked by the user in the user-designation area 54 for each image file.*” column 5, lines 1-27).

Lopez 318 does not expressly disclose scanning a plurality of pages using a scanner adapted for printing to produce a scan job of one or more documents; providing a user interface at the scanner for a user to approve the scan job, or rescan the plurality of pages, or edit settings for the scan job, or cancel the scan job; receiving user input through the user interface at the scanner, wherein the user input comprises one of the following: (a) input to approve the scan job, (b) input to rescan the plurality of pages, (c) input to edit settings for the scan job, or (d) input to cancel the scan job; and sending the scan job to a remote computer or computer peripheral on a network if the user input was the input to approve the scan job, whereby enabling the user to proof the scan job before sending the scan job to the remote computer or the computer peripheral on the network.

Nomura '724 discloses scanning a plurality of pages using a scanner adapted for printing to produce a scan job of one or more documents (See Figure 2 wherein Fig. 2 shows the scanner #3 “*The scanner*

3 has an auto reading mode and manual reading mode. In the auto reading mode, sheet-shaped documents are automatically fed by the automatic document feeder 4, and scanned sheet-by-sheet to be exposed, so as to read document images." column 8, lines 26-30);

providing a user interface at the scanner for a user to approve the scan job, or rescan the plurality of pages, or edit settings for the scan job, or cancel the scan job (See Figure 4 wherein Fig. 4 shows an operation panel provided with a large-sized LCD. The operation panel is for the scanner of the image forming system. #302a start is the start key and #302c is the clear key. See also Figure 20a which shows a scanner display section, which is provided to a scanner operating section. *"The start key 302a is a key for giving instructions to start a process of a mode set by using the various keys. The all clear key 302b clears whole setting of the image forming system 1, so as to restore a standard condition of the image forming system 1. The clear key 302c clears condition, which is inputted by the ten keys 302d and the like."* column 9, lines 39-44);

receiving user input through the user interface at the scanner, wherein the user input comprises one of the following: (a) input to approve the scan job, (b) input to rescan the plurality of pages, (c) input to edit settings for the scan job, or (d) input to cancel the scan job (See Figure 4 wherein Fig. 4 shows an operation panel provided with a large-sized LCD. The operation panel is for the scanner of the image forming system. #302a start is the start key and #302c is the clear key. See also Figure 20a which shows a scanner display section, which is provided to a scanner operating section. *"The start key 302a is a key for giving instructions to start a process of a mode set by using the various keys. The all clear key 302b clears whole setting of the image forming system 1, so as to restore a standard condition of the image forming system 1. The clear key 302c clears condition, which is inputted by the ten keys 302d and the like."* column 9, lines 39-44);

and sending the scan job to a remote computer or computer peripheral on a network if the user input was the input to approve the scan job, whereby enabling the user to proof the scan job before sending the scan job to the remote computer or the computer peripheral on the network, (*"The display section 301 of the operation panel 300 has a default picture plane (standby picture plane), which is a photocopying mode picture plane as shown in FIG. 5... this, the display section 301 displays a picture plane shown in FIG. 6. Here, the scanning mode is a process mode in which the document read by the scanner 3 is transmitted to a receiver. Examples*

of the scanning mode include fax communication, SCAN TO E-mail, SCAN TO FTP (FTP: File Transfer Protocol) and the like." column 9, lines 53-64).

Lopez '318 and Nomura '724 are combinable because they are from same field of endeavor of image forming systems ("The present invention relates to an image forming system provided, in combination, with (a) a scanner for optically reading a document image and (b) a printer for forming an image on a recording medium..." Nomura '724 at column 1, lines 7-10).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the image forming system as taught by Lopez '318 by adding means to scan/rescan a plurality of pages and modify a scan job as taught by Nomura '724. The motivation for doing so would have been because it is advantageous to provide a more user-friendly image forming apparatus. Therefore, it would have been obvious to combine Lopez '318 with Nomura '724 to obtain the invention as specified in claim 1.

Regarding claim 2; Lopez '318 discloses rendering the entire scan job after sending ("The image printing subsystem 84 renders each image file 2 according to the printing instructions, and sends the print content to the printer subsystem 80 for generating the image prints 26." column 5, lines 31-35).

Regarding claim 3; Lopez '318 discloses the proof sheet includes one or more thumbnail images representing one or more respective pages of the scan job ("...FIG. 3A is a detailed plan view of an exemplary combination proof sheet and order form 22 that may be utilized with the system 10 of FIG. 1A to select one or more images from an array of thumbnail images such as 52 (FIG. 3C) for final printing." column 5, lines 63-67);

Regarding claim 4; Lopez '318 discloses where the proof sheet includes descriptive information describing the scan job ("The scanned image is communicated from the scanner subsystem 86 to a proof sheet analyzer subsystem 82. The proof sheet analyzer subsystem 82 detects and interprets the markings made by the user in the user designation areas 54 (also known as image selection areas 54) to identify the user-selected image files 2, and

associates each of the individual user designation areas 54 with a corresponding image file URL 73 via the identity marker 60.” column 5, lines 13-23).

Regarding claim 8; Lopez ‘318 as modified does not expressly disclose where the user input comprises input to edit settings for the scan job; where the method further comprising the step of storing the scan job in a memory; and receiving user instruction and modifying the stored scan job according to said user instruction prior to said step of sending.

Nomura ‘724 discloses where the user input comprises input to edit settings for the scan job (See Figure 4 wherein Fig. 4 shows an operation panel provided with a large-sized LCD. The operation panel is for the scanner of the image forming system. #302a start is the start key and #302c is the clear key. See also Figure 20a which shows a scanner display section, which is provided to a scanner operating section. ***“The start key 302a is a key for giving instructions to start a process of a mode set by using the various keys. The all clear key 302b clears whole setting of the image forming system 1, so as to restore a standard condition of the image forming system 1. The clear key 302c clears condition, which is inputted by the ten keys 302d and the like.”*** column 9, lines 39-44);

the method further comprising the step of storing the scan job in a memory (“...in the image forming system 1, both display contents of the printer 2 and the scanner 3 are stored in a VRAM (Video Random Access Memory) (display information storing means) 223a of the printer controller 223. A memory is saved, because the respective detailed information of the printer 2 and the scanner 3 is administered in a unitary manner by the printer controller 223 of the printer 2 in this manner.” column 10, lines 37-63);

receiving user instruction and modifying the stored scan job according to said user instruction prior to said step of sending (See Figure 4 wherein Fig. 4 shows an operation panel provided with a large-sized LCD. The operation panel is for the scanner of the image forming system. #302a start is the start key and #302c is the clear key. See also Figure 20a which shows a scanner display section, which is provided to a scanner operating section. ***“The start key 302a is a key for giving instructions to start a process of a mode set by using the various keys. The all clear key 302b clears whole setting of the image forming system 1, so as to restore a standard condition of the image forming system 1. The clear key 302c clears condition, which is inputted by the ten keys 302d and the like.”*** column 9, lines 39-44);

Lopez '318 and Nomura '724 are combinable because they are from same field of endeavor of image forming systems (*"The present invention relates to an image forming system provided, in combination, with (a) a scanner for optically reading a document image and (b) a printer for forming an image on a recording medium..."* Nomura '724 at column 1, lines 7-10).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the image forming systems as taught by Lopez '318 by adding means to edit, store or modify a scan job as taught by Nomura '724. The motivation for doing so would have been because it is advantageous to provide a more user-friendly image forming apparatus. Therefore, it would have been obvious to combine Lopez '318 and Nomura '724 with Nomura '724 to obtain the invention as specified in claim 1.

Regarding claim 9; Lopez '318 discloses the proof sheet includes one or more thumbnail images representing one or more respective pages of the scan job (*"...FIG. 3A is a detailed plan view of an exemplary combination proof sheet and order form 22 that may be utilized with the system 10 of FIG. 1A to select one or more images from an array of thumbnail images such as 52 (FIG. 3C) for final printing."* column 5, lines 63-67);

Regarding claim 12 & 21; Claims 12 & 21 contain substantially the same subject matter as claim 1. Therefore, claims 12 & 21 are rejected on the same grounds as claim 1. However, the only difference is that claim 21 adds a computer-readable medium configured to store a set of instructions executable to perform the method of claim 1 and claim 12 is the apparatus for claim 1. At column 5, lines 53-57, Lopez '318 discloses a computer-readable medium configured to store a set of instructions executable to perform the method (*"The above-described subsystems... are preferably implemented in firmware or software stored on a program storage medium such as a ROM, CD-ROM, or the like and executable by a processor or microcomputer (not shown) disposed within printer 14..."*)

Regarding claims 13 & 22; Claims 13 & 22 contain substantially the same subject matter as claim 2. Therefore, claims 13 & 22 are rejected on the same grounds as claim 2.

Regarding claims 14 & 23; Claims 14 & 23 contain substantially the same subject matter as claim 4. Therefore, claims 14 & 23 are rejected on the same grounds as claim 4.

Regarding claims 18 & 27; Claims 18 & 27 contain substantially the same subject matter as claim 8. Therefore, claims 18 & 27 are rejected on the same grounds as claim 8.

Regarding claims 19 & 28; Claims 19 & 28 contain substantially the same subject matter as claim 9. Therefore, claims 19 & 28 are rejected on the same grounds as claim 9.

Regarding claim 30; The method of claim 1, wherein the proof sheet comprises only compressed forms of a first page in the scanned documents and a last page in the scanned documents (See Figure 1B, Proof Sheet #22 and #54 the user designation area. Here, a user has the option to choose which page to have on the proof sheet to include but not limited to the first and last page in accordance with the selected image files. See column 5, lines 8-35)

Regarding claim 31; The method of claim 1, wherein if the proof sheet comprises more than one sheet, all non-image information is omitted from all but one of the sheets (See Figure 3E wherein #'s 52 & 54 shows where all non-image information is omitted from all but one of the sheets. See also column 7, line 58 thru column 8, line 3).

Regarding claim 32; The method of claim 1, wherein the compressed form of the page is rotated differently than the page in scanned documents (See Figure 1B, user designation area #54. Here, a user designates an image with print instructions. These printing instructions print size may incorporate instructions such as border size and color, rotation and etc. Thus, a user by his choice may rotate the thumbnail image differently than a page in the scanned document. See column 5, lines 8-35)

Examiner Notes

6. The Examiner cites particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully considers the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or as disclosed by the Examiner.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCUS T. RILEY whose telephone number is (571)270-1581. The examiner can normally be reached on Monday - Friday, 7:30-5:00, est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcus T. Riley
Assistant Examiner
Art Unit 2625

/MARCUS T. RILEY/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625